

## REMARKS

Applicant notes that all the previous prior art references are no longer cited against the present invention.

### Claim rejections under 35 U.S.C. § 103

In item 3, claims 8, 9, 12-14, 17, 19, 20, 22, 23, 26-28, 31, 33, 34, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urano (JP Pub No 09-218738) in view of Carroll et al (the '960 patent). Specifically regarding claims 8, 22 and 36, Figs. 1 and 2 of Urano are asserted to teach a touchpad keyboard. Urano is admitted not to teach visual feedback or audio feedback of a pre-recorded sound. However, Carroll is asserted to teach visual feedback when keys are touched, and an "audio feedback system that causes pre-recorded sound to be made audible whenever any key of the plurality of keys is touched..."

Applicant respectfully traverses the rejection of claims 8, 22 and 36, based on the combination of the references Urano and Carroll. First, and probably most importantly, Urano teaches a touch sheet that does not operate as a touchpad. A touchpad generates signals that indicate the present position of a pointing object on a surface of the touchpad. Urano does not teach generating or sending signals of the present position of a pointing object on a touchpad. Urano teaches that "when a user depresses a printed key part, a corresponding key code is outputted by detecting the depressing. Thus, the operation of the touchsheet of Urano teaches away from the present invention because the touchsheet sends keycodes, not location data as is sent by a touchpad.

Second, Urano states that the problem being solved is to provide a full-size keyboard for a user of a portable device such as a portable computer or cell phone. Urano teaches away from the present invention when it states that a keyboard that can fit into a small device "is too small and inconvenient."

In contrast, the present invention teaches that the touchpad is "a miniature full function keyboard that is coupled to a small electronic appliance." Thus, whereas the present invention is a small, compact full-function keyboard, Urano teaches a full-size keyboard. Applicant respectfully asserts that a prior art reference teaching a full-size keyboard does not make the present invention obvious.

Regarding Carroll, the cited passages of the patent teach an input scheme (col. 2, lines 64-65) wherein the user can speak commands (audibly directs) certain keys to be activated. This passage does not teach anything about audio feedback.

The second cited passage (col. 11, lines 47-51) teaches that "sound" can be used "when a user has touched the input device."

Applicant respectfully traverses the assertion that Carroll makes obvious the use of pre-recorded sounds as taught by the present invention. It is noted that the Examiner has withdrawn the objection based upon Fernando that taught using computer-generated spoken words. The present invention specifically uses pre-recorded sounds in order to overcome the issue of clarity that often results from computer-generated sounds. Thus, it is not an issue that other inventions teach sound as a feedback device. However, it is asserted and claimed that pre-recorded sounds provide a unique advantage for the present invention.

Regarding claims 9 and 23, it is asserted that the combination of Urano and Carroll teaches that the audio feedback system includes a pre-recorded voice that states a name of an associated key that has been touched. However, the cited passage used to make this assertion is col. 2, lines 64-65 of Carroll that is actually addressing using audible voice commands to activate keys, not to generate audio feedback as explained above. According, Applicant traverses the rejection of these claims.

Regarding claims 12 and 26, it is asserted that Urano teaches a communications cable.

Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims. Furthermore, Applicant repeats the assertion that Urano does not teach a touchpad as understood by those skilled in the art of touchpads as previously explained in defense of claims 8 and 23 above.

Regarding claims 13 and 27, it is asserted that Urano teaches that the hand-held and portable electronic appliances include a mobile telephone.

Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims. Furthermore, Applicant repeats the assertion that Urano does not teach a touchpad as understood by those skilled in the art of touchpads as previously explained in defense of claims 8 and 23 above.

Regarding claims 14 and 28, it is asserted that Urano teaches that the communications port is a wire.

Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims. Furthermore, Applicant repeats the assertion that Urano

does not teach a touchpad as understood by those skilled in the art of touchpads as previously explained in defense of claims 8 and 23 above.

Regarding claims 17 and 31, it is asserted that Urano teaches that the touchpad is a finger or stylus responsive device.

Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims. Furthermore, Applicant repeats the assertion that Urano does not teach a touchpad as understood by those skilled in the art of touchpads as previously explained in defense of claims 8 and 23 above.

Regarding claims 19 and 33, it is asserted that the combination of Urano and Carroll teach at least a second dedicated key that is programmable to actuate a computer program.

Application respectfully traverses the rejection of these claims. The cited passage of Carroll (col 6, line 65 to col. 7, line 9) teaches a representation of at least one key for activating an input function. A keyboard input function is not understood by those skilled in the art to be actuation of a program. Furthermore, Carroll only teaches a representation of a key, whereas the present invention teaches an actual key. In addition, Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims. Furthermore, Applicant repeats the assertion that Urano does not teach a touchpad as understood by those skilled in the art of touchpads as previously explained in defense of claims 8 and 23 above.

Regarding claims 20 and 34, it is asserted that the combination of Urano and Carroll inherently teach a mode switch that enables the touchpad keyboard to switch

between functioning as a touchpad keyboard and as a cursor control device.

Applicant respectfully traverses the rejection of these claims based upon the combination of Urano and Carroll. First, Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims. Second, Applicant repeats the assertion that Urano does not teach a touchpad as understood by those skilled in the art of touchpads as previously explained in defense of claims 8 and 23 above. Third, Carroll does not teach a touchpad. The present invention teaches that the touchpad is "a miniature full function keyboard that is coupled to a small electronic appliance." Thus, whereas the present invention is a small, compact full-function keyboard, Carroll teaches a full-size touchscreen. Applicant respectfully asserts that a prior art reference teaching a full-size keyboard and a full-size touchscreen does not make the present invention obvious.

Regarding claim 37, it is asserted that the combination of Urano and Carroll teach a microphone for recording audio data for transmission via a network, and for live transmission of audio data for transmission via a network.

Application respectfully traverses the rejection of these claims. The cited passage of Carroll (col 11, lines 35-45) teaches that a microphone is used to receive voice commands. In no part of Carroll has Applicant found any mention of the recording of any voice data. Also, Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims.

In item 4, claims 10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urano (JP Pub No 09-218738) in view of Carroll et al (the '960

patent), and further in view of Griffin (the '255 patent). Specifically, while Urano and Carroll do not teach a mechanical scrolling wheel, it is asserted that Griffin teaches a mechanical scrolling wheel in the side of a keyboard.

Application respectfully traverses the rejection of these claims. The present invention teaches that the touchpad is "a miniature full function keyboard that is coupled to a small electronic appliance." Thus, whereas the present invention is a small, compact full-function keyboard, Carroll teaches a full-size touchscreen, Urano teaches a full-size keyboard, and Griffin teaches a full-size keyboard. Applicant respectfully asserts that prior art references teaching a full-size keyboard and a full-size touchscreen do not make the present invention obvious. Also, Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims.

In item 5, claims 11 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urano (JP Pub No 09-218738) in view of Carroll et al (the '960 patent), and further in view of Martinelli (the '790 patent).

Application respectfully traverses the rejection of these claims. The present invention teaches that the touchpad is "a miniature full function keyboard that is coupled to a small electronic appliance." Thus, whereas the present invention is a small, compact full-function keyboard, Carroll teaches a full-size touchscreen, Urano teaches a full-size keyboard. The addition of Martinelli does not make the present invention more obvious. Also, Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims.

In item 6, claims 15, 16, 29 and 30 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Urano (JP Pub No 09-218738) in view of Carroll et al (the '960 patent), and further in view of Holehan (the '902 patent). Holehan is asserted to teach a plurality of raised ridges 122 that provided tactile feedback.

Application respectfully traverses the rejection of these claims. Holehan does not teach raised ridges. Holehan teaches tactile response elements 122 that are disposed underneath an overlay. These "ridges" are thus underneath an overlay, not on top of it. Also, Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims.

In item 7, claims 18, 21, 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urano (JP Pub No 09-218738) in view of Carroll et al (the '960 patent), and further in view of Grant (the '039 patent).

Application respectfully traverses the rejection of these claims. The combination of Urano and Carroll have already been shown to not make the present invention obvious because whereas the present invention is a small, compact full-function keyboard, Carroll teaches a full-size touchscreen, Urano teaches a full-size keyboard. The addition of a dedicated web navigation key does not make the present invention any more obvious. Also, Applicant respectfully traverses the rejection of these claims as being based upon allowable independent claims.

In light of the statements above, Applicant respectfully requests issuance of claims 8 to 37. If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the examiner is invited to call David W. O'Bryant at (801) 478-0071 so that such matters

may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0881.

DATED this 15th day of July, 2004.

Respectfully submitted,



David W. O'Bryant  
Attorney for Applicant  
Registration No. 39,793  
MORRISS O'BRYANT COMPAGNI, P.C.  
136 South Main Street, Suite 700  
Salt Lake City, Utah 84101  
(801) 478-0071 telephone  
(801) 478-0076 facsimile